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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,398	02/25/2002	Salim G. Kara	61135/P004CP1CP1C2/101074	5850

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EXAMINER

COSIMANO, EDWARD R

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 04/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,398

Applicant(s)

KARA, SALIM G.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-16,19-25 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-16,19-25 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.

2. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data in paragraph number 1 on page 1 in reference to application 09/491,949,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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4.1 Claims 1, 6-16, 21-25 & 27-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuessler (2,964,323) in view of replacing a manual activity with automatic activity, In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958).

4.1.1 In regard to the following rejection:

A) it is noted that as would be clearly understood by one of ordinary skill at the time of the invention, both a postage indicia and a cancelled postage stamp provide the same function, that is they each provide proof of the payment of an amount of postage, it would have been obvious to one of ordinary skill that these items are in fact equivalent representations of the same thing.

B) claim 1, it is noted that claim 1 is directed to an article, that is an “envelope” and not either the contents of the envelope or a combination of the envelope and the contents of the envelope. Hence the newly added material to claim 1, “wherein said postage indicia is affixed to a postal item inserted into said envelope, wherein said postal item bearing said postal indicia is a computer generated document, and wherein said postage indicia is printed directly upon said postal item at a time of printing said computer generated document” is directed to nonfunctional descriptive material that may not distinguish an article over the prior art, note that nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

4.1.2 In regard to claims 1, 6-16, 21-25 & 27-36, Schuessler ('323) discloses envelope 31 containing three glassine, that is cellophane, 36 covered windows 33, 34 & 35, where cellophane 36 protects the contents 10 of envelope 31 while permitting the underlying portions of contents 10 to be viewed from the outside of envelope 31. It is further noted that covered windows 33, 34 & 35 are positioned on the front of envelope 31 such that when:

A) sender/return address 16,27;

B) addressee/recipient address 15,26; and

C) postmark 17,30;

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which have been printed as part of contents 10 so that when contents 10 has been properly folded and inserted into envelope 31, then the addressee/recipient address 15,26 is clearly viewable through covered window 33 in the lower left portion of envelope 31; the sender/return address 16,27 is clearly viewable through covered window 34 in the upper left portion of envelope 31; and the postmark 17,30 is clearly viewable through covered window 35 in the upper right portion of envelope 31.

4.1.3 In regard to using a computer to generated the postage and contents at the same time, Schuessler ('323) does not disclose the use of a computer to create and generate the contents of the envelope. However, Schuessler ('323) does suggest that:

A) it is desirable to reduce the time required to complete forms to make this process more efficient; and

B) the information that is to be placed in specified locations on the contents of the envelope is performed manually by the user.

Since it is well known that the use of a computer to complete and generate various forms speeds up the processing of the forms as a whole, it would have been obvious to one of ordinary skill at the time of the invention that the manual completion of contents 10 of the envelope 31 by the user of Schuessler ('323) could be automatically performed by a computer system in order to save time and make the process more efficient.

4.2 Claims 4, 5, 19 & 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuessler (2,964,323) in view of In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958) as applied above to claims 1, 6-16, 21-25 & 27-35, and further in view of either Gunn (GB 1380590) or Sansone et al (4,724,718) or Gilham (EP 0331352).

4.2.1 In regard to claims 4, 5, 19 & 20, Schuessler ('323) does not disclose that the postmark 17,30 includes a machine readable portion (claims 4 & 19) or that the machine readable portion (claims 5 & 20). However, it was known in 1975 as indicated by figs. 1, 2 & 3 of Gunn ('590); or it was known 1988 as indicated by figs. 2 & 3 of Sansone et al ('718); or it was known in 1989 as indicated by fig. 1 of Gilham ('352) that a postmark may contain both human readable and machine readable portions which are user for sorting mail and verification of the postage paid and the postmark. Further as taught by these references the machine

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readable portion may comprise a series of dots, as indicated by figs. 1, 2 & 3 of Gunn ('590) or a suitable barcode as indicated by figs. 2 & 3 of Sansone et al ('718) and by fig. 1 of Gilham ('352). Since, as taught by either Gunn ('590) or Sansone et al ('718) or Gilham ('352) it is well known that a postmark may comprise machine readable portions in the form of a plain text and encrypted information in the nature of a suitable barcode, it would have been obvious to one of ordinary skill at the time of the invention that the postmark of Schuessler ('323) could contain machine readable portions in the nature of a suitable barcode so as to aid the Postal authority in sorting mail and verifying the postage paid and postmarks on the mail.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

5.1 A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR § 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Response to applicant's arguments.

6.1 All rejections and objections of the previous Office action not repeated or modified and repeated here have been overcome by applicant's last response.

6.2 As per the 35 U.S.C. § 103 rejection, since applicant has chosen to include the use of a computer in the instant claims and this examiner has used computerized word processing applications since the early nineteen nineties, one of ordinary skill would have been readily able to automate, without undue experimentation, the implementation of completing of the form of Schuessler (2,964,323) by a computer. Hence, applicant's arguments are non-persuasive.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783 (after 13 April 2005 (571) 272-6802). The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702 (after 13 April 2005 (571) 272-6812). Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

7.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

7.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

7.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

03/24/05


Edward R. Cosimano
Primary Examiner A.U. 3639